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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,918	01/26/2005	Dieter Sauter	103196-00006	8417
4372	7590	10/19/2006	EXAMINER	
ARENT FOX PLLC 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			HAUPT, KRISTY A	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/500,918

Applicant(s)

SAUTER ET AL.

Examiner

Kristy A. Haupt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 11-13, 15-17, 19, 22 and 23 is/are rejected.
- 7) ☒ Claim(s) 6-7, 9-10, 14, 18 and 20-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/04, 2/05, 7/06
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 8, 11-13, 15-17, 19, and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by McCabe et al. US 6,068,192.

McCabe teaches:

With respect to claim 1:

- A value or security document wherein said value or security document includes a circuit (Figure 2 teaches circuit, #18) and said circuit is provided with a break adapted to be closed by a conducting element (Abstract and Figure 2 teaches smart card housing that closes so that contact, #20 of conductor, #16 comes into contact with power supply, #15 and contact, #21 of conductor, #16 comes into contact with contact of circuit, #18, thereby closing the circuit and allowing the card to function)

With respect to claim 2 and incorporating all limitations of claim 1:

- Wherein said conducting element is situated on the document and said conducting element is movable across the break by forming the document (Figure 2 teaches conducting element, #16 that is situated on smart card,

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#10 and wherein the conductor, #16 is moved to come into contact with conductor, #14 by forming the housing of the card (Column 5, Lines 22-27))

With respect to claim 8 and incorporating all limitations of claim 1:

- Wherein a security feature is activatable by closing the break with the conducting element (Abstract teaches that if the housing is separated then the circuit is opened and the connection to the battery is broken so that data held in the memory is erased)

With respect to claim 11 and incorporating all limitations of claim 1:

- Comprising a battery and/or a solar cell and/or an antenna power supply (Figure 2, #15 teaches a power supply that is a battery (Column 5, Lines 3-4))

With respect to claim 12 and incorporating all limitations of claim 11:

- Wherein said break is designed in such manner that the security feature is activated by closing the break with the conducting element (Abstract teaches that if the housing is separated then the circuit is opened and the connection to the battery is broken so that data held in the memory is erased)

With respect to claim 13 and incorporating all limitations of claim 1:

- A first circuit pattern and a second circuit pattern which are separated from one another by the break and superimposable one upon the other by forming of the document so that the break is closed (Figure 2 teaches conducting element, #16 that is situated on smart card, #10 and wherein the conductor, #16 is moved to come into contact with conductor, #14 by forming the housing of the card (Column 5, Lines 22-27))

With respect to claim 15 and incorporating all limitations of claim 1:

- A substrate made of a paper and/or a plastics film (Column 6, Lines 4-5 teaches the housing is made of plastic)

With respect to claim 16 and incorporating all limitations of claim 15:

- Wherein one or several elements of the circuit, in particular the conducting element, are printed onto the document by means of a printing ink (Column 9, Lines 7-8 and 24-35)

With respect to claim 17, a method of manufacturing a value or security document, said method comprising the steps of:

- Providing a substrate (Column 9, Lines 7-8)
- Printing a circuit onto said substrate (Column 9, Lines 7-8 and 24-35), said circuit having a break and said break being closable by a conducting element (Abstract and Figure 2 teaches smart card housing that closes so

that contact, #20 of conductor, #16 comes into contact with power supply, #15 and contact, #21 of conductor, #16 comes into contact with contact of circuit, #18, thereby closing the circuit and allowing the card to function)

With respect to claim 19 and incorporating all limitations of claim 17:

- Printing a first circuit pattern and a second circuit pattern which are separated from one another by the break so that by forming of the document the first circuit pattern and the second circuit pattern are superimposable one upon the other (Figure 2 teaches conducting element, #16 that is situated on smart card, #10 and wherein the conductor, #16 is moved to come into contact with conductor, #14 by forming the housing of the card (Column 5, Lines 22-27))

With respect to claim 22 and incorporating all limitations of claim 1:

- Wherein the break comprises a physical break (Abstract teaches the conducting elements (Figure 2, #'s 16 and 17) are on separates and when connected together they close the circuit; therefore there is a physical break in the circuit until the housing is closed and the conductors come into contact with one another)

With respect to claim 23 and incorporating all limitations of claim 1:

- Wherein the conducting element is formed of an electro conducting printing ink (Column 9, Lines 7-8 and 24-35)

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCabe et al. US 6,068,192 in view of Kokubu US 5,710,421.

McCabe fails to teach:

With respect to claim 3:

- Wherein said document forming operation involves a kinking, bending, rolling and/or folding process

With respect to claim 4:

- Wherein said value or security document has a predetermined kinking, bending and/or folding line or a kinking, bending and/or folding zone along which the forming operation essentially takes place

With respect to claim 5:

- Wherein said predetermined kinking, bending and/or folding line or kinking, bending and/or folding zone is constructed in such manner that the forming operation is essentially reversible

However, Kokubu teaches:

With respect to claim 3 and incorporating all limitations of claim 2:

- Wherein said document forming operation involves a kinking, bending, rolling and/or folding process (Abstract)

With respect to claim 4 and incorporating all limitations of claim 3:

- Wherein said value or security document has a predetermined kinking, bending and/or folding line or a kinking, bending and/or folding zone along which the forming operation essentially takes place (Abstract teaches the two halves are connected by a self-hinge portion)

With respect to claim 5 and incorporating all limitations of claim 4:

- Wherein said predetermined kinking, bending and/or folding line or kinking, bending and/or folding zone is constructed in such manner that the forming operation is essentially reversible (Column 4, Lines 27-29 teach the halves can be unfolded to function as a contact type card)



Therefore, it would have been obvious to one of ordinary skill in the art to modify the invention of McCabe to form the document by a kinking, bending, rolling and/or folding process, as taught by Kokubu, to protect the surface of the contact by having it located inside the housing when folded (Column 1, Lines 58-62).

***Allowable Subject Matter***

5. Claims 6-7, 9-10, 14, 18 and 20-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is an examiner's statement of reasons for allowance:

With respect to claim 6 and all its dependencies:

- The break is constructed to be closable by an external conducting element

With respect to claim 9 and all its dependencies:

- The security feature is realized by a component that is designed to issue a visual and/or audible and/or electromagnetic signal

With respect to claim 10 and all its dependencies:

- A protective coat provided on at least one section of the circuit and having an aperture in the region of the break so that it is exposed

With respect to claim 14 and all its dependencies:

- The first circuit pattern and the second circuit pattern result in a coil subsequent to the document forming operation

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With respect to claim 18 and all its dependencies:

- Applying a protective coat to at least one section of the circuit and having apertures in the region of the break so that it is exposed

With respect to claim 20 and all its dependencies:

- The first circuit pattern is a first coil winding half and the second is a second coil winding half with a layer of insulating printing ink printed over a region of the coil winding halves

The prior art of record fails to provide sufficient teaching or motivation to one of ordinary skill in the art to provide the features of these claims in the combinations as claimed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristy A. Haupt whose telephone number is (571) 272-8545. The examiner can normally be reached on M-F 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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